

Case No. Dunn et al. 1-1
SL&W No. 6005-103US
S&L No. P27,414 USA

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR (S) : Jeffrey H. Dunn & Cynthia E. Martin
Application No. : 10/825,777
Filed : April 15, 2004
Title : AUTHENTICATION MECHANISMS FOR CALL
CONTROL MESSAGE INTEGRITY AND
ORIGIN VERIFICATION
Docket No. : Dunn et al. 1-1

Commissioner for Patents
Mail Stop Petition
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date of Deposit : *1/26/05*

Name : Thomas J. Onka, 42,053

Signature

Thomas J. Onka

Date of Signature : *1/26/05*

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR 1.47(b)

Attorneys for Lucent Technologies, Inc. (Lucent) respectfully petition the Commissioner of Patents and Trademarks to accept this submission in response to the enclosed Decisions Refusing Status Under 37 CFR 1.47 (b); which Decisions, with respect to Applicant Dunn, cites as missing item (2) "an acceptable oath or declaration" and item (5) "proof of proprietary interest", and with respect to Applicant Martin, item (2) only.

In response to the above mentioned items, enclosed please find:

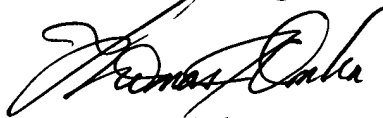
1. An acceptable Declaration and Power of Attorney executed by Matthew Hodulik, Esq.; authorized signatory of Lucent Technologies, on behalf of Jeffrey H. Dunn and Cynthia E. Martin.
2. Declaration of Matthew J. Hodulik, Authorized Signatory of Lucent Technologies, Inc.
3. Legal Memorandum executed by Thomas J. Onka, Esq. in response to item (5), stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to Lucent.

Petitioner respectfully asks that this petition be accepted to preserve the rights of Lucent in this matter.

Sincerely,

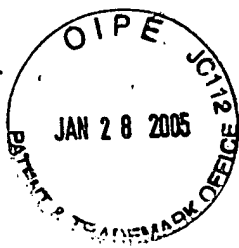
Lucent Technologies, Inc.

By



Thomas J. Onka
Attorney for Lucent Technologies, Inc.
Reg. No. 42,053

Synnestvedt Lechner and Woodbridge LLP
P. O. Box 592
Princeton, NJ 08542-0592
Tel. (609) 924-3773
Fax (609) 924-1811



Lucent Docket No. Dunn et al.1-1
Our Client No. P27,414USA
6005-103

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Declaration and Power of Attorney

As the below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I am an attorney, registered to practice before the United States Patent and Trademark Office, and I am authorized by Lucent Technologies Inc., to whom the invention identified herein rightfully belongs, to sign this Declaration and Power of Attorney on its behalf. Jeffrey H. Dunn and Cynthia E. Martin, to the best of my knowledge and belief, are the original and sole inventors of the subject matter which is claimed and for which a patent is sought on the invention entitled **AUTHENTICATION MECHANISMS FOR CALL CONTROL MESSAGE INTEGRITY AND ORIGIN VERIFICATION** the specification of which was filed on April 15, 2004 under U.S. Application No. 10/825,777.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by an amendment, if any, specifically referred to in this oath or declaration.

I acknowledge the duty to disclose all information known to me which is material to patentability as defined in Title 37, Code of Federal Regulations, 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

None

I hereby claim the benefit under Title 35, United States Code, 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, 112, I acknowledge the duty to disclose all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

None

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both,

under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint the following attorney(s) with full power of substitution and revocation, to prosecute said application, to make alterations and amendments therein, to receive the patent, and to transact all business in the Patent and Trademark Office connected therewith:

Kenneth M. Brown	(Reg. No. 37590)
Donald P. Dinella	(Reg. No. 39961)
Martin I. Finston	(Reg. No. 31613)
Barry H. Freedman	(Reg. No. 26166)
Julio A. Garceran	(Reg. No. 37138)
Jimmy Goo	(Reg. No. 36528)
Stephen M. Gurey	(Reg. No. 27336)
David W. Herring, Jr.	(Reg. No. 51069)
Matthew J. Hodulik	(Reg. No. 36164)
Irena Lager	(Reg. No. 39260)
John B. MacIntyre	(Reg. No. 41170)
Christopher N. Malvone	(Reg. No. 34866)
John F. McCabe	(Reg. No. 42854)
James Milton	(Reg. No. 46935)
Gregory J. Murgia	(Reg. No. 41209)
Eugene J. Rosenthal	(Reg. No. 36658)
Steven R. Santema	(Reg. No. 40156)
David A. Sasso	(Reg. No. 43084)
Ozer M. N. Teitelbaum	(Reg. No. 36698)
Jeffrey M. Weinick	(Reg. No. 36304)

I hereby appoint the attorney(s) on ATTACHMENT A as attorney(s) in the aforementioned application, with full power solely to prosecute said application, to make alterations and amendments therein, to receive the patent, and to transact all business in the Patent and Trademark Office connected with the prosecution of said application. No other powers are granted to such attorney(s) and such attorney(s) are specifically denied any power of substitution or revocation.

Signature of Attorney for
Applicant, Lucent Technologies Inc.

Matthew J. Hodulik

Date

1/25/05

Matthew J. Hodulik
Reg. No. 36164

Post Office Address
of Attorney for Applicant:

9 Cross Brook Drive
Califon, NJ 07830

Full name of 1st joint inventor: Jeffrey H. Dunn

Inventor's
signature

Matthew J. Hodulik

Date

1/25/05

Matthew J. Hodulik, Authorized Signatory of Lucent Technologies Inc., on behalf of
and as agent for Jeffrey H. Dunn

Residence: 4214 Crest Place, Ellicott City, Maryland 21043

Citizenship: USA

Post Office Address: Same as above

Full name of 2nd joint inventor: Cynthia E. Martin

Inventor's
signature

Matthew J. Hodulik

Date

1/25/05

Matthew J. Hodulik, Authorized Signatory of Lucent Technologies Inc., on behalf of
and as agent for Cynthia E. Martin

Residence: 10263 Wilde Lake Terrace, Columbia, Maryland 21044

Citizenship: USA

Post Office Address: Same as above

ATTACHMENT A**Attorney/Patent Agent Names:**

Richard C. Woodbridge	26,423	Lisa B. Lane	38,217
Stuart H. Nissim	33,541	Charles H. Lindrooth	20,659
Thomas J. Onka	42,053	Theodore Naccarella	33,023
Roy Rosser	53,533	Joseph F. Posillico	32,290
Len Smith	53,139	Mark D. Simpson	32,942
Jane E. Alexander	36,014	Joshua R. Slavitt	40,816
Robert F. Axenfeld	37,276	Marilou E. Watson	42,213
Alexis Barron	22,702	Stephen J. Weed	45,202
Gregory S. Bernabeo	44,032	Gene J. Yao	47,193
Peter J. Butch, III	32,203	Jonathan M. Dermott, Ph.D.	48,608
John A. Chionchio	40,954	Peter D. Mlynek, Ph.D.	47,802
Christopher P. Dahling	51,140	Brett T. Freeman	46,709
Stephen J. Driscoll	37,564	Gary A. Hecht	36,826
H. Eric Fischer	46,010	Joseph M. Imhof	41,863
Patrick J. Kelly, Ph.D.	34,638		

Telephone calls should be made to Synnestvedt & Lechner LLP at:

Phone No.: 215-923-4466

Fax No.: 215-923-2189

All written communications are to be addressed to:

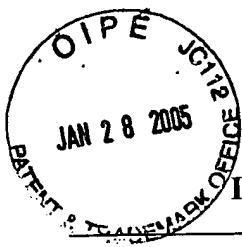
Robert F. Axenfeld, Esq.

Synnestvedt & Lechner LLP

2600 Aramark Tower

1101 Market Street

Philadelphia, Pa. 19107-2950



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Dunn and Martin

Application No.: 10/825,777

Filing Date: April 15, 2004

For: AUTHENTICATION MECHANISMS FOR CALL CONTROL
MESSAGE INTEGRITY AND ORIGIN VERIFICATION

**DECLARATION OF MATTHEW J. HODULIK, AUTHORIZED SIGNATORY OF
LUCENT TECHNOLOGIES INC.**

I, Matthew J. Hodulik, hereby declare the following:


1. I am Corporate Counsel for Lucent Technologies Inc. ("Lucent"). In this position I have authority to act on behalf of Lucent with respect to the assignment and filing of patent applications.
2. I am familiar with the subject patent application, U.S. Patent Application 10/825,777.
3. To my knowledge, Mr. Jeffrey H. Dunn and Ms. Cynthia Martin are the sole inventors of the invention claimed in the subject patent application ("Invention").
4. Mr. Dunn and Ms. Martin were each hired to conduct research on behalf of Lucent. To my knowledge the subject matter of the Invention is within the scope of their employment. In particular, they invented the Invention while in the employ of Lucent – developing the Invention at a Lucent facility; with the knowledge and approval of their supervisor, Mr. Penafiel Pablo; while being paid by Lucent for doing this research.

5. Mr. Dunn's and Ms. Martin's refusal to execute a declaration in this application poses a significant risk of irreparable harm to Lucent, as a company stands to lose its valuable rights to patent the Invention in the United States.

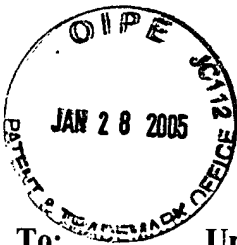
6. I hereby declare that all statements made herein of my own knowledge are true, all statements made on information and believe are believed to be true, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: _____

1/25/05



Matthew J Hodulik
Corporate Counsel
Lucent Technologies Inc.



LEGAL MEMORANDUM

To: United States Patent & Trademark Office – Office of Petitions
From: Thomas J. Onka
Date: January 14, 2005
Re: Employer's rights to its Employee's Invention / Maryland Federal & State Law

Summary

This Memorandum is being submitted in support of a petition under 37 CFR 1.47(b) filed by Lucent Technologies ("Lucent"). I, Thomas J. Onka, have researched the law of the State of Maryland, the jurisdiction in which inventor Jeffrey Dunn (Dunn) both resided and worked at the time of the subject invention. This Memorandum asserts that under Maryland law, a court would, by the weight of legal authority in that jurisdiction, award the title of the employee's invention to Lucent.

Applicable Facts

In January 2004, Thomas Onka, Esq. (Onka) of Synnestvedt, Lechner and Woodbridge (SL&W), commenced work on preparing a patent application titled "AUTHENTICATION MECHANISMS FOR CALL CONTROL MESSAGE INTEGRITY AND ORIGIN VERIFICATION" that was subsequently filed on April 15, 2004 as U.S. Patent Application 10/825,777 (the application).

Initially, the sole two inventors Dunn and Cynthia Martin (Martin) aided Onka in the preparation of the amendment. On or about February 18, 2004, the inventors refused any additional assistance. Subsequent to that refusal, the application was prepared primarily by Onka's reliance upon materials disclosed in a paper entitled "Authentication Mechanisms for Call Control Message Integrity and Origin Verification in Asynchronous Transfer Mode (ATM) and Frame Relay (FR) Networks" authored by Martin and Dunn and submitted by them on or about March 10, 2003 for publication in the Bell Labs Technical Journal. The Bell Labs Technical Journal publishes work-related articles submitted by Lucent employees. This particular article was published on or about February 18, 2004 in Vol. 8, No. 3, pages 79-91 of that journal.

At the time of their hire, both Dunn and Martin were asked to sign Lucent employee agreements which are “intended to formalize in writing certain understandings and procedures of Lucent Technologies Inc.” (opening paragraph). Paragraph 3 of this Agreement expressly recites an obligation of the employee to assign his inventions. Martin signed her agreement, Dunn did not.

As confirmed by their immediate supervisor, Pablo Penafiel (Penafiel), Dunn and Martin were hired as inventors to conduct research. Initially they worked in the area of systems integration and unit testing of telecommunications systems. As stated by Penafiel, Lucent maintains a policy of giving inventors freedom in pursuing other areas of research that contribute to Lucent goals. Under this policy Dunn and Martin, with the knowledge and approval of their supervisor Penafiel, commenced work on the invention that is the subject matter of the application. During this work Dunn and Martin were paid by Lucent for their time.

Applicable Law

It is well-settled under various Federal and State laws that even in the absence of an express agreement of assignment, an employer has a right to an employee’s inventive work where (as here) the employer specifically employs or directs the employee to exercise his inventive faculties (e.g., *Teets v. Chromalloy Gas Turbine Corp.*, 83 F.3d 403, 407 (Fed. Cir. 1996).

Turning now to Maryland State law, for an employer to have a valid claim of title, the inventions must be made by employees during course of employment and in connection with work for which they were employed. See *St. Louis & O’Fallon Coal Co. v. Dinwiddie et al.*, 53 F. 2d 665, D. Maryland, 1933. An invention made incidentally by an employee, even if it is achieved at his employer’s expense, belongs to the employee *Id* at. 662. If, however, the employee is engaged to devise or perfect a particular article or process, all discoveries made by him in connection therewith belong to the employer. *Id*.

With respect to a situation where an express agreement of assignment was not signed by the employee, the rule adopted by the Maryland Courts is that “the right of the employer to the invention or discovery of the employee depends not upon the terms of the original contract of hiring, but upon the nature of the service in which the employee

is engaged at the time he makes the discovery” and that the employee owes to his employer “a duty with respect to the service in which he is engaged” because “during the period that he is engaged, he is employed to invent”. See *Crown Cork & Seal v. Fankhanel*, 49 F. Supp 611, D. Maryland (1943) at 614. The court went on to note:

The broad principle is now laid down by the Supreme Court, too clearly to be misunderstood, that, when an employee merely does what his is hired to do, his successes, as well as failures, belong to his employer. Nor can it be said that one who willingly carries out the orders of his employer is not engaged upon that which he is employed to do. An employee, who undertakes upon the direction of his employer to solve a specific problem within the scope of his general employment, is as truly employed and paid for the particular project as if it had been described at the outset in the contract of employment. *Id* at 615

Conclusion

Dunn was hired to invent and the subject matter of the invention described in the application is within the scope of that employment. Moreover, Dunn was supervised and paid to develop the invention and did so on company time and in a company facility. As evidenced by the submission of their invention for publication in the Bell Labs Technical Journal, both Dunn and Martin were employees of Lucent at the time of that invention. There is no doubt that under these facts and under the applicable law of the State of Maryland, Dunn’s invention which is the subject matter of U.S. Patent Application 10/825,777 belongs to his employer, Lucent. A Maryland court of competent jurisdiction would, by the weight of legal authority in that State, award the title of the invention to Lucent.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas J. Onka', written in a cursive style.

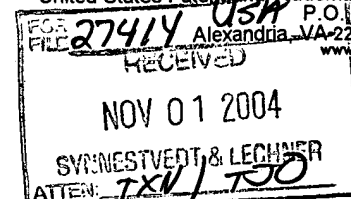
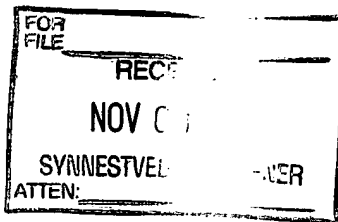
Thomas J. Onka, Esq.



UNITED STATES PATENT AND TRADEMARK OFFICE



SYNNESTVEDT & LECHNER, LLP
2600 ARAMARK TOWER
1101 MARKET STREET
PHILADELPHIA PA 19107-2950



COPY MAILED

OCT 27 2004

OFFICE OF PETITIONS

In re Application of
Jeffrey H. Dunn and **Cynthia E. Martin**
Application No. 10/825,777
Filed: April 15, 2004
For: AUTHENTICATION MECHANISMS FOR
CALL CONTROL MESSAGE INTEGRITY AND
ORIGIN VERIFICATION

:
:
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(b)
:

ENTERED COMPUTER

12-27-04

This is in response to the petition under 37 CFR 1.47(b), filed August 27, 2004, regarding non-signing inventor **Cynthia E. Martin**.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)" and may include an oath or declaration executed by the inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on April 15, 2004 without an executed oath or declaration and naming Jeffrey H. Dunn and **Cynthia E. Martin** as joint inventors.

Accordingly, on June 28, 2004, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on August 27, 2004, the instant petition was filed.

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration;

- (2) an acceptable oath or declaration;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest; and
- (6) proof of irreparable damage.

Applicant lacks item (2), as set forth above.

The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b). See MPEP 409.03(b).

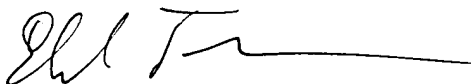
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 Box 1450
 Alexandria, VA 22313

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA

Telephone inquiries should be directed to the undersigned at
(571) 272-3228.

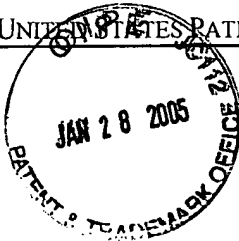
A handwritten signature in black ink, appearing to read 'Ed Tannouse', followed by a long horizontal line.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
United States Patent and Trademark Office

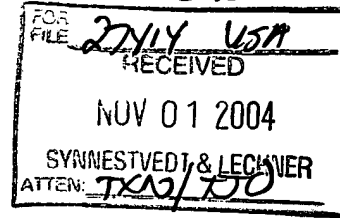


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:

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12-27-04

This is in response to the petition under 37 CFR 1.47(b), filed August 27, 2004, regarding non-signing inventor **Jeffrey H. Dunn**.

The petition is dismissed.

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- (5) proof of proprietary interest; and
- (6) proof of irreparable damage.

Applicant lacks items (2) and (5), as set forth above.

Regarding Item (2):

The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b). See MPEP 409.03(b).

Regarding Item (5):

As the Employment Agreement with non-signing inventor **Jeffrey H. Dunn** is unsigned, Rule 47 applicant failed to show or provide proof that Lucent Technologies, Inc. (Lucent) has sufficient proprietary interest in the subject matter to justify the filing of the application (see MPEP 409.03(f)). Acceptable proof would include a copy of the signed employment agreement between the

non-signing inventor and Lucent, a copy of a signed assignment agreement showing that the invention disclosed in the application is assigned to Lucent, or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to Lucent.

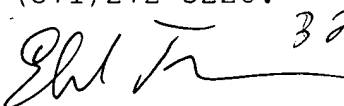
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By hand: Office of Petitions
 2201 South Clark Place
 Crystal Plaza 4, Suite 3C23
 Arlington, VA

Telephone inquiries should be directed to the undersigned at (571)272-3228.

 3282

Edward J. Tannouse
Petitions Attorney
Office of Petitions
United States Patent and Trademark Office